

ESTTA Tracking number: **ESTTA341130**

Filing date: **04/07/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Tiffany (NJ) LLC
Granted to Date of previous extension	04/07/2010
Address	15 Sylvan Way Parsippany, NJ 07054 UNITED STATES

Attorney information	Richard Lehv Fross Zelnick Lehrman & Zissu PC 866 United Nations Plaza New York, NY 10017 UNITED STATES rlehv@frosszelnick.com, lapolzon@frosszelnick.com Phone:2128135928
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### Applicant Information

Application No	77664798	Publication date	12/08/2009
Opposition Filing Date	04/07/2010	Opposition Period Ends	04/07/2010
Applicant	Formosa Sunrise Corporation 14975 Technology Drive Fort Myers, FL 33912 UNITED STATES		

### Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Women's formal dresses and gowns, prom dresses and gowns, dresses and gowns for formal social occasions
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2708223	Application Date	06/15/1995
Registration Date	04/22/2003	Foreign Priority Date	NONE
Word Mark	TIFFANY & CO.		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1987/02/01 First Use In Commerce: 1987/02/01 scarves

U.S. Registration No.	1251356	Application Date	02/16/1982
Registration Date	09/13/1983	Foreign Priority Date	NONE
Word Mark	TIFFANY & CO.		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1868/00/00 First Use In Commerce: 1868/00/00 Retail Store Services Specializing in the Sale of: Jewelry; Watches and Clocks; Stationery; Chinaware; Figurines; Silver Flatware, Coffee Services, Bowls, Trays, Picture Frames, and Boxes; Desk Accessories; Bar Accessories; Clothing Accessories; Baby Gifts; Smoker's Accessories; Crystal Glasses, Bowls, Vases, Jars, Candlesticks, Boxes, Buckets, and Baskets; Precious and Semi-Precious Stones; Dies for Engraving, Stamping, or Embossing Stationery; Flexible Stainless Measuring Tapes; [ Thermometers; ] Barometers; Medals and Medallions; Metal Plates from which Book Plates Are Stricken Off; Non-Electric Lamps; Candelabra; Playing Cards; [ Sewing Kits; Ironstone Dinnerware; ] Earthenware Boxes and Baskets; and Ashtrays		

Related Proceedings	Opposition No. 91172112
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Attachments	Notice of Opposition - Tiffany Designs by House of Wu (F0606514).PDF ( 8 pages )(229503 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Richard Lehv/
Name	Richard Lehv
Date	04/07/2010

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 77664798  
Published in the *Official Gazette* on December 8, 2009

-----X	:	
TIFFANY (NJ) LLC,	:	
	:	Opposition No.
Opposer,	:	
	:	
- v. -	:	<b>NOTICE OF OPPOSITION</b>
	:	
FORMOSA SUNRISE CORPORATION,	:	
	:	
Applicant.	:	
-----X		

Tiffany (NJ) LLC (“Tiffany” or “Opposer”), a limited liability company duly organized and existing under the laws of the state of Delaware with a principal place of business at 15 Sylvan Way, Parsippany, New Jersey 07054, believes that it will be damaged by the issuance of a registration for the trademark TIFFANY DESIGNS BY HOUSE OF WU, applied for in Application Serial No. 77664798, filed February 6, 2009 for “Women’s formal dresses and gowns, prom dresses and gowns, dresses and gowns for formal social occasions” in International Class 25 and therefore opposes the same. As grounds for the opposition, Opposer, by its attorneys, Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

1. The TIFFANY mark has been used in the U.S. by Opposer or its predecessors for more than 150 years. Today, Opposer is one of the most famous companies in the world and the TIFFANY brand is recognized worldwide as designating goods and services exclusively from Opposer.

2. Numerous courts and tribunals worldwide have held that TIFFANY is a famous trademark. Similarly, the U.S. Senate has deemed TIFFANY to be an extraordinarily famous mark. This fame is attributable to the more than 150 years of use of the TIFFANY mark, the

extensive sales of TIFFANY products, the extensive advertising and promotional efforts featuring the TIFFANY mark, and the extensive reference to TIFFANY in the media and popular culture.

3. Tiffany sells its products under the TIFFANY mark in more than 50 retail stores in the U.S., as well as through direct marketing channels including catalogs, and on its website.

4. All products sold by Tiffany are sold and packaged in boxes or bags that prominently bear the TIFFANY trademark. The TIFFANY trademark also is prominently displayed and used on Tiffany's website, on its catalogs (of which in excess of 20 million are distributed each year), and in its stores.

5. Tiffany is the owner of more than 60 U.S. federal trademark registrations for the mark TIFFANY and its variant TIFFANY & CO. (hereinafter collectively referred to as the "TIFFANY mark") covering a wide variety of goods and services. In connection with International Class 25, Opposer owns Registration No. 2,708,223 for the mark TIFFANY & CO. for scarves, issued April 22, 2003, based on first use on February 1, 1987. Opposer also owns Registration No. 1,251,356 for TIFFANY & CO. for retail store services specializing in the sale of numerous items, including "clothing accessories," among other goods, issued on September 13, 1983.

6. Opposer's registrations for the TIFFANY mark are valid, subsisting and in full force and effect and serve as evidence of Opposer's exclusive right to use the mark in commerce on or in connection with the goods and services identified in the registrations as provided by Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(b). Registration numbers 2,708,223 and 1,251,356 (identified in paragraph 5) as well as many other registrations of Opposer are incontestable and serve as conclusive evidence of Opposer's exclusive right to use the TIFFANY mark for the listed goods and services.

7. By virtue of Opposer's extensive sales, advertising and promotion of its goods under

its mark, the TIFFANY mark has become instantly recognizable to the public as exclusively denoting Opposer, its goods and services. In addition, the TIFFANY mark has come to symbolize the high quality of Opposer's products. As a result of Opposer's substantial effort and investment on behalf of its brand, the goodwill inherent in the TIFFANY mark is an enormously valuable asset of Opposer.

8. On information and belief, Applicant, Formosa Sunrise Corporation, is a Florida corporation with a principal place of business at 14975 Technology Drive, Fort Myers, Florida 33912.

9. On February 6, 2009, Applicant filed Application Ser. No. 77664798 to register the mark TIFFANY DESIGNS BY HOUSE OF WU for women's formal dresses, gowns, and prom dresses in International Class 25.

10. Upon information and belief, Wen Jong Wu is the owner or is otherwise a principal of Applicant.

11. Applicant's filing date is long after Opposer's date of first use of its TIFFANY mark and long after the date the TIFFANY mark was first registered in the U.S. Patent and Trademark Office. Indeed, Opposer owns registrations for its mark dating to the Nineteenth century. (*E.g.*, Registrations Nos. 23,572 and 23,573, both registered in 1893.) Applicant's filing date is long after the TIFFANY mark had achieved extraordinary fame in the U.S. and throughout the world.

12. When Applicant sought to register TIFFANY DESIGNS BY HOUSE OF WU, Applicant had actual knowledge of Tiffany's prior rights in and to the TIFFANY mark.

13. Prior to filing the application opposed herein, Applicant's owner or principal, Wen Jong Wu, filed Application Ser. No. 76541932 to register TIFFANY DESIGNS (in a design format) for the identical goods as set forth in the opposed application. The Patent and Trademark Office refused registration because of a likelihood of confusion with Opposer's

TIFFANY mark, finding that the marks create the same overall commercial impression, that Opposer's marks are famous due to use since the 1868 and extensive public recognition, that Opposer's marks are entitled to a broad scope of protection, and that Applicant's dresses and gowns for proms and social occasions "are closely related to [Opposer's] ties and scarves and retail store services featuring, *inter alia*, clothing and accessories." The Trademark Examining Attorney found that, since the marks were substantially similar and the goods and services closely related, there was a likelihood of confusion and refused registration. That earlier application was abandoned for failure to respond to the Office Action.

14. Applicant's filing of the opposed application occurred *after* Applicant's principal had filed a now-abandoned application for TIFFANY DESIGNS, *after* the prior application had been rejected because of a likelihood of confusion with Opposer's prior-used TIFFANY mark, *after* Applicant received a demand letter from Opposer, and *after* Applicant was put on notice of Opposer's rights.

15. In addition to having actual notice of Opposer's rights in the TIFFANY mark, as a matter of law Applicant was on constructive notice of Opposer's rights in its TIFFANY mark based on Opposer's registrations in existence at the time Applicant applied to register TIFFANY DESIGNS BY HOUSE OF WU.

16. The mark applied for, TIFFANY DESIGNS BY HOUSE OF WU, incorporates Opposer's TIFFANY trademark and is confusingly similar to Opposer's TIFFANY mark. The inclusion of the descriptive word "designs" is not source identifying and does not create a mark that is dissimilar from Opposer's mark. As previously noted by the PTO in connection with Applicant's earlier filed application to register the mark TIFFANY DESIGNS, the "recognizable and dominant portion of applicant's mark is the word 'TIFFANY' which is identical to the recognizable and dominant portion of [Opposer's] marks. In the instant case, it is appropriate to give less weight to the 'DESIGNS' portion of applicant's mark because of the descriptive nature

of the word. . . . As such, viewed as a whole, the applicant's mark is substantially similar in sound, appearance, connotation and commercial impression to the registered mark." The reasoning of the Trademark Examiner in connection with the prior application applies equally here. The inclusion of the words "BY HOUSE OF WU" does not lessen, alleviate or eliminate the likelihood of confusion, since consumers will simply believe that HOUSE OF WU is a licensee of Opposer, that Opposer approved or endorsed Applicant's goods, or that Opposer and Applicant are otherwise connected or affiliated, when that is not the case.

17. The goods for which Applicant seeks registration are clearly related to the goods and services offered by Opposer under its TIFFANY mark. Opposer sells products that are regularly used with formal wear, including, but not limited to, jewelry and other accessories for clothing. In addition, Opposer owns registrations for and uses its TIFFANY mark in connection with clothing items, such as scarves. The Patent and Trademark Office has already found that the goods identified in the opposed application are related to Opposer's goods and services such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. Further, the presence of Opposer's TIFFANY mark in the opposed mark, for goods related to those offered by Tiffany, will inevitably cause consumers to believe that Opposer has licensed Applicant to use the mark for such goods.

18. Applicant's application is unrestricted as to consumers. As a result, it is presumed that Applicant's goods will be offered to all consumers including those of Opposer's goods and services.

19. The registration of Applicant's mark is inconsistent with Opposer's prior rights in its TIFFANY mark as well as inconsistent with Opposer's statutory grant of exclusivity of use of its registered mark and would harm, damage or destroy Opposer's investment and goodwill in its mark.

### **CLAIM FOR RELIEF UNDER SECTION 2(f)**

20. Opposer repeats and re-alleges each and every allegation contained in paragraphs 1 through 19 as if fully set forth herein.

21. The TIFFANY mark is inherently distinctive, has been used in commerce and widely advertised by Opposer for many years, is instantly recognized by consumers as a symbol of Opposer and its products and services, and is the subject of incontestable federal trademark registrations. Courts and legislatures have deemed the TIFFANY mark to be a famous and distinctive mark entitled to protection from dilution. As a result, the TIFFANY mark is a famous mark under the Lanham Act.

22. Applicant's application to register TIFFANY DESIGNS BY HOUSE OF WU was filed long after the TIFFANY mark became famous.

23. Registration of the mark TIFFANY DESIGNS BY HOUSE OF WU is likely to and would dilute the distinctive quality of Opposer's TIFFANY mark by causing an association between the opposed mark and Opposer's famous mark that impairs the distinctiveness of the famous TIFFANY mark.

24. Registration of the mark TIFFANY is likely to dilute the TIFFANY mark, in violation of Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f).

25. By reason of the foregoing, Opposer is likely to be harmed by registration of Application Ser. No. 77664798 for the mark TIFFANY DESIGNS BY HOUSE OF WU.

### **CLAIM FOR RELIEF UNDER SECTION 2(d)**

26. Opposer repeats and re-alleges each and every allegation contained in paragraphs 1 through 19 as if fully set forth herein.

27. Opposer's TIFFANY mark is exclusively associated with Opposer and has been used continuously by Opposer since a date prior to any date on which Applicant can rely.

28. Applicant's TIFFANY DESIGNS BY HOUSE OF WU mark incorporates and is



substantially similar to Opposer's registered and prior used TIFFANY mark and has a similar sound, meaning, appearance and commercial impression to Opposer's mark. In addition, Applicant seeks to register its mark for goods related in consumers' minds to the goods long provided by Opposer under its mark.

29. By virtue of Opposer's longstanding use of the TIFFANY mark, the goodwill associated with the mark, and Opposer's incontestable registrations therefor, the registration by Applicant of TIFFANY DESIGNS BY HOUSE OF WU for goods related to the goods and services provided by Opposer is likely to cause confusion or cause mistake or to deceive the purchasing public into mistakenly believing that Applicant's goods offered under the TIFFANY DESIGNS BY HOUSE OF WU mark originate from, come from or are otherwise associated with Opposer, or that Applicant's goods are endorsed, licensed, or sponsored by or in some way connected with Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

30. By reason of the foregoing, Opposer is likely to be harmed by registration of the mark TIFFANY DESIGNS BY HOUSE OF WU, shown in Application Ser. No. 77664798.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and that the registration sought by Applicant in Application Ser. No. 77664798 be denied.

The Trademark Trial and Appeal Board is hereby authorized to charge the opposition filing fee to Opposer's counsel's deposit account No. 23-0825-0576900.

Dated: New York, New York  
April 7, 2010

FROSS ZELNICK LEHRMAN  
& ZISSU, P.C.

By: 

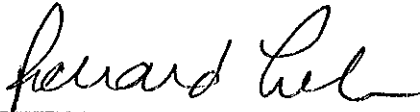
Richard Lehv  
Attorneys for Opposer  
866 United Nations Plaza  
New York, New York 10017  
(212) 813-5900

### Certificate of Service

I hereby certify that a true and complete copy of the foregoing Notice of Opposition is being served by first-class mail, postage prepaid, on the attorney of record for the applicant at the following address:

Jennifer L. Whitelaw  
Whitelaw Legal Group  
3838 Tamiami Trl N Ste 310  
Naples, Fl 34103-3586

this 7th day of April, 2010.

A handwritten signature in cursive script, appearing to read "Richard Lehy", written over a horizontal line.

Richard Lehy